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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,325	12/10/2001	Bryan C. Dunkeld	KOP 2001-1	4756
23694 7590 05/29/2008 J. NICHOLAS GROSS, ATTORNEY 2030 ADDISON ST. SUITE 610 BERKELEY, CA 94704				
EXAMINER				
AUGUSTIN, EVENS J				
ART UNIT		PAPER NUMBER		
3621				
MAIL DATE		DELIVERY MODE		
05/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/016,325

Applicant(s)

DUNKELD ET AL.

Examiner

EVENS J. AUGUSTIN

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-37.55 and 59-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-37.55 and 59-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Affidavit or Declaration Under 37 CFR 1.131: Ineffective

1. The declaration filed on 07/17/ 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the O’Kane cited reference.
2. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the cited reference to either a constructive reduction to practice or an actual reduction to practice. The evidence in the exhibits does not show anywhere a date that is before November 21, 2001. For example, the first page of Exhibit 2 shows that the page was last printed on 07/14/2007, but does not show a date that is prior to November 21, 2001. The finality of the office action mailed on 12/07/2007 has been withdrawn, to allow applicant to provide evidence dated prior to November 21, 2001. Claims 22-37, 55 and 59-80 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Regarding claims 22, 24, 25, 27, 35, and 37, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. In this case, the language of "and/or" does not make clear whether the succeeding language is included, as part of the

limitation or it is in the alternative. This language does not inform the public of the boundaries of what constitutes infringement of the patent. For example in claim 22, it not clear whether the second computer is included in the limitation or is an alternative to the first computer.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 22-37, 55 and 59-80 are rejected under 35 U.S.C. 102(e) as being anticipated by O’Kane et al. (U.S. 20030097299) (“O’Kane”).

As per claims 22-37, 55 and 59-80, O’Kane discloses an invention that relates to the art of transferring data files between users and, more specifically, to the use of peer to peer processing for this purpose. The invention comprises of the following:

- A P2P network with a plurality of clients (first, second or third) connected to it (par. 56)–
Claims 22, 23
- The client computers include software module that is operable (or executable) to enable these machines to access the network and be capable of consuming system resources

provided by other systems connected to the network (aka managing the transfer/download of content) (par. 58) –

- The aspect of content instantiation is being interpreted by the PTO as being content transfer or download. Accordingly, each time the content is downloaded (first, second or third time), the downloaded content has unique tag (par. 62) –
- Paragraph 16 of the prior art teaches that users in the art can use cellular phone, Personal Digital Assistant etc, as client devices –
- Audio files such as MP3 format (par. 96)-
- The **unique tag** is based on the IP address of the originated and computer and file name to be downloaded (par. 62) –
- The basics of P2P operation are a user requests a file(s) to be downloaded and the other user or server makes available the file(s) to be downloaded (par. 10-13) –
- Computer program executable to complete an authorization procedure (par. 90). authorization procedures also enable the digital information to be distributed for a limited number of uses/users, thus enabling per-use fees to be charged for the digital information (par. 50). Implicitly, a transaction account has to set up in order to charge users for content. Additionally, the language in claim 30 does not require steps of “setting up account” to be performed –
- A system that manages that upload and download of files through the P2P network (par. 64) –
- The current invention will allow a person to send a file once and see it **hosted** by dozens or even thousands of potential consumers on a network (par. 39, 52, 56, 57)-

Art Unit: 3621

- Provides payments to the parties involved for performing the hosting function (par. 52, 69) –
- Requesting or polling for files (par. 64) –
- Prior art teaches the aspect of digital content which includes among other things, text, graphical images, sound files, and the like (par. 6, 96-101). Books and magazines would fall under the category of text or graphical images –
- Transfers and downloads must oblige to United States copyright laws such as the Digital Millennium Act of 1998 (par. 31) –
- The client device can be an MP3 or video player (par. 112), and it is well established in the art that MP3 player can be part of personal entertainment system –
- Client computers having memory (par. 56-58) –

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EVENS J. AUGUSTIN whose telephone number is 571-272-6860. The examiner can normally be reached on 10am - 6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571)272-6779.

/Evens J. Augustin/
Evens J. Augustin
May 31, 2008
Art Unit 3621